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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,158	01/31/2002	Alexander Govyadinov	10019410 -1	3575

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

WILLE, DOUGLAS A

ART UNIT	PAPER NUMBER
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2814

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/066,158

Applicant(s)

GOVYADINOV ET AL.

Examiner

Douglas A Wille

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 20-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,10-12,16-18 and 40 is/are rejected.
- 7) ☒ Claim(s) 3,9,13-15 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>0902</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 - 50, drawn to a device, classified in class 257, subclass 10.
- II. Claims 51 - 60, drawn to a method, classified in class 438, subclass 20.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the method can be used to form an emitter without a separate cathode.

3. Should Applicant elect group I, it is further restricted as follows;

- III. Claims 1 - 27, drawn to a device, classified in class 257, subclass 10.
- IV. Claim 28, drawn to a device, classified in class 313, subclass 364+.
- V. Claims 33 - 38, drawn to a device, classified in class 250, subclass 310.
- VI. Claims 39 - 50, drawn to a device, classified in class 315, subclass 169.3.

4. Inventions III and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as

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claimed because an anisotropic conductivity layer is not needed. The subcombination has separate utility such as an emitter without a regulatory function.

5. Inventions III and V are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because an anisotropic conductivity layer is not required. The subcombination has separate utility such as unfocussed emitter.

6. Inventions I and VI are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination could be made with a device having an electron source. The subcombination has separate utility such as an emitter with an electron source.

7. Should Applicant elect group III it is further restricted as follows;

8. This application contains claims directed to the following patentably distinct species of the claimed invention: claims 1, 20, 22, 23-24,25,26 and 27.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

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Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Should Applicant elect group V, it is further restricted as follows;

9. This application contains claims directed to the following patentably distinct species of the claimed invention: claims 33, 34, 35, 36, 37 and 38.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, 33 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable

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thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

10. A telephone call was made to Timothy Myers on 18 February 2004 to request an oral election to the above restriction requirement which resulted in the election of claims 1 – 19 with traverse.

11. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

13. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

14. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. A 2% efficiency is claimed but such is not supported by the specification and the specification does not indicate how such an efficiency can be achieved.

15. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claims 1 -19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

17. Claim 1 refers to sheet resistance but it appears that resistivity is intended. It is also noted that the reference to sheet is not understood.

18. Claim 8 refers to the resistivity in the thickness direction as being larger than half the resistivity in the length and width directions and therefore the thickness resistivity can be larger than the transverse resistivity. Is this intended?

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19. Claim 10 refers to the layer as being self organized. This is not understood and there is no support for a specific mechanism to create this self organization.

20. Claim 18 refers to the conductivity as being greater than that of the substrate. What direction of conductivity does this refer to?

***Claim Rejections - 35 USC § 102***

21. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

22. Claims 1, 2, 4, 5, 12 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsukamoto et al.

23. With respect to claim 1, Tsukamoto et al. show (see cover Figure and column 2, line 39 et seq.) an emitter with an electron source 11, a continuous anisotropic layer 17 and a cathode 17, 18, 19.

24. With respect to claim 2, the SiO<sub>2</sub> layer 11 is a tunneling layer.

25. With respect to claim 4, the structures 21 are equivalent to Spindt tips.

26. With respect to claim 5, the structures 21 are not on specific centers.

27. With respect to claim 12, the Tsukamoto et al. structures are poly (column 3, line 39).

28. With respect to claim 17, the Tsukamoto et al. device can be considered as being micropatterned



***Claim Rejections - 35 USC § 103***

29. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

30. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukamoto et al.

31. Tsukamoto et al. does not specify the efficiency but it would be obvious to design the device to produce high efficiency, specifically greater than 2%.

32. Claims 6, 8, 10, 11, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukamoto et al. in view of Kumar and Yamamoto et al.

33. With respect to claims 6 and 16, Tsukamoto et al. show the basic device and Kumar show a similar device which uses Spindt tip like emitters of diamond (see cover Figure and column 4, line 30 et seq.). Yamamoto et al. show that for Spindt tip type devices either diamond or diamond like carbon can be used (column 3, line 14). It would have been obvious to use the diamond tips shown by Kumar in the Tsukamoto et al. device as a design alternative and to use diamond like carbon in place of diamond as a design alternative.

34. With respect to claim 8, the Kumar structure could have roughly equivalent resistance in the parallel and perpendicular directions. See also paragraph 18 above.

35. With respect to claim 10, the Kumar device is self organized in that no outside control is provided for the placement of the diamond emitters.

36. With respect to claim 11, Yamamoto et al. show an assembled array.

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37. With respect to claim 18 Tsukamoto et al. do not specify the resistivities of the silicon films but it would be an obvious design tradeoff to select the relative resistivities to meet design objectives.

***Allowable Subject Matter***

38. Claims 3, 9, 13 – 15 and 19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

39. The prior art does not show an emissive layer on the tunneling layer, specific resistivity values in the claimed range, a columnar structure or a plurality of pn junctions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas A Wille whose telephone number is (571) 272-1721. The examiner can normally be reached on M-F (6:15-2:45).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy can be reached on (571) 272-1705. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "Douglas A. Wille". The signature is fluid and cursive, with the first name "Douglas" being more prominent and the last name "Wille" following in a similar style.

Douglas A. Wille  
Primary Examiner